

REMARKS

1. The Examiner has maintained the 35 USC 102 novelty objection to claims 1-3, 8-18, 22-25, 27-29, 34-48, 40, 41, 43, 44, 46-57, 61-64, 66-71, 73, 74, 76, 77, 79-92, 96-99, 101-108, 110, 112 and 113 on the basis of US5,799,157 (Escallon).

2. In response, the Applicant has proposed to amend the claims in order to more clearly distinguish the claimed invention from Escallon. In particular, the amended claims are not anticipated by Escallon for the following reasons:

19
E yes
{ 1 (a) Escallon does not disclose a "form ... including printed coded data": Escallon is only concerned with electronic forms and does not disclose forms with printed coded data thereon. Even if the Escallon electronic forms were printed out, those forms would not include printed coded data.

E yes 2 { (b) Escallon does not disclose any printed coded data which is "indicative of an identity of the form and of at least one reference point of the form": Escallon does not disclose any printed coded data at all, let alone printed coded data which is indicative of the identity of the printed form and indicative of a reference point of the printed form.

E not 3 { (c) Escallon does not disclose "a hand-held sensing device": The Examiner has previously argued that "Transaction management server 220 of Escallon is a sensing device." Escallon's transaction management server is a large computer which could not be accurately described as a hand-held sensing device.

3. Wilz discloses a printed form with printed barcodes on it. However, Wilz' barcodes do not fall within the scope of the "printed coded data" as defined in the claims for the following reasons:

7 { (a) Wilz' barcodes are not "indicative of an identity of the form": If Wilz's barcodes were indicative of the identity of the form on which they appeared, one would expect Wilz' barcodes to include some kind of page identifier which identified that page. However, Wilz does not disclose such a page identifier. The only information represented by the barcode is the URL of a website. When users wish to visit one of the web sites, they use a bar code

scanner to read the bar code. The Wilz system identifies the URL associated with the bar code and the Internet browser then displays the corresponding web page. In this way the Wilz barcode is indicative of a URL, but it is not indicative of the identity of the form upon which the barcode is printed.

Wilz therefore does not disclose "*printed coded data indicative of an identity of the form.*"

(b) Wilz' barcodes are not "*indicative of ... at least one reference point of the form*"; As mentioned above, Wilz' barcodes are only indicative of a URL and do not indicate any reference points on the printed form.

Wilz therefore does not disclose "*printed coded data indicative of ... at least one reference point of the form.*"

4. The Applicant notes that on the last occasion the Examiner did not discuss exactly what Wilz' barcodes were indicative of, but merely glossed over the issue. The Examiner correctly stated that Wilz discloses coded forms but did not go into any detail about the nature of the Wilz barcodes and what information they were indicative of. The Applicant is confident that the Examiner will agree that Wilz' forms do not contain "*printed coded data indicative of an identity of the form and of at least one reference point of the form*" as is claimed.

5. It should also be noted that the nature of the claimed coded data has an effect on the nature of the sensing device, since the sensing device is able to "*generat[e] the indicating data using at least some of the sensed coded data*", the indicating data being defined in at least one of the independent claims as "regarding the identity of the form and a position of the sensing device relative to the form." Neither citation discloses a sensing device which generates such indicating data using printed coded data.

6. Since neither Escallon nor Wilz disclose all of the claimed features either alone or in combination, the applicant submits that independent claims 1, 27, 46, 66, 79 and 101 are both novel and inventive in light of the citations. Similar comments apply in relation to the dependent claims.

handheld
scanner

7. The Applicant submits that when this application was first examined it was clear from the context of the present specification that the claimed forms were forms with printed coded data on them. For this reason, the Applicant submits that the Examiner should have searched for prior art relating to printed coded forms in the initial search and that additional searching should not be necessary based on the limited claim amendments made in this response.

Similar comments apply in relation to the limitation that the sensing device is a "hand-held" sensing device. This was clear from the specification as a whole (eg Figure 8) at the time this application was first examined.

8. The Examiner has maintained his objection to the independent claims on the grounds that that are indefinite because it is not clear how the sensing device is manoeuvred. In response, the Applicant has amended the claims so that it is clear that the sensing device is a "hand-held" sensing device which is manoeuvred "*when placed by a hand of the user in an operative position relative to the form.*" The Applicant submits that the independent claims are now clear.

9. Under "Priority 35 U.S.C. §§ 119 and 120" of the Office Action dated December 12, all certified copies of the priority document have been received. However, under "Priority 35 U.S.C. §§ 119 and 120" of the Office Action dated May 12, 2003, none of the certified copies of the priority document have been received. According to our records, the documents were sent by Fedex to the United States Patent & Trademarks Office on November 15, 2000 (date of the Transmittal Form). The Applicant would be grateful if the Examiner could confirm whether copies of the priority documents have been received.

10. In light of the above arguments and amendments the Applicant requests that the Examiner reconsider his objections and allow this application to issue.

CONCLUSION

It is respectfully submitted that all of the Examiner's objections have been successfully traversed. Accordingly, it is submitted that the application is now in condition for allowance. Reconsideration and allowance of the application is courteously solicited.

Very respectfully,

Applicant:



KIA SILVERBROOK



PAUL LAPSTUN



JACQUELINE ANNE LAPSTUN

C/o: Silverbrook Research Pty Ltd
393 Darling Street
Balmain NSW 2041, Australia.

Email: kia.silverbrook@silverbrookresearch.com

Telephone: +612 9818 6633

Facsimile: +61 2 9818 6711